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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,006	11/17/2003	Alan H. Brown	1477-002-US	3287
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CATALYST LAW GROUP, APC 9710 SCRANTON ROAD, SUITE S-170 SAN DIEGO, CA 92121			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/715,006	Applicant(s) BROWN ET AL.	
	Examiner Carolyn M. Bleck	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/04, 6/20/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed on 17 November 2003. Claims 1-18 are pending. The IDSs filed on 2/23/04 and 6/20/05 have been entered and considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: positively reciting any elements of the claimed apparatus (i.e., a web site, a client computer, a server). Further, Applicant appears to be claiming an apparatus, however, the body of the claim appears directed towards method steps of accessing healthcare information and storing healthcare information.

As per claim 9, line 2, the Examiner respectfully submits that it is unclear what Applicant means by the recitation of "wherein data on said secured website is coded."

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For example, does Applicant mean that the data is formatted based on a particular language, such as HTML? Does Applicant intend that the term coded mean that the data is encrypted? Applicant is requested to clarify what the term "coded" means. For purposes of applying prior art, the Examiner has interpreted the term coded to mean both encryption of data and the formatting of data in HTML.

Claim 10 recites "providing users with patient's healthcare information" within the preamble. However, the step within the body of the method claim fails to actually recite a step that provides a user with the patient's healthcare information. Processing healthcare information on a website does not necessarily "provide users with patient's healthcare information." Claim 10 recites "wherein said method comprises." It is unclear whether the method actually recites any steps because Applicant has claimed the method steps within a "wherein clause." Examiner suggests positively reciting the steps within the method. Further, it is unclear what Applicant means by "processing" information on a website. Does Applicant mean that the information is processed for display on a website? Does Applicant mean that a user can access the data through a website? The Examiner requests clarification of this step.

As per claim 11, lines 1-2, "patient's healthcare information data" appears to lack proper antecedent basis. It appears this phrase should read "patient's healthcare information." Further, claim 12, line 1, "said data" appears to also lack antecedent basis. For purposes of applying prior art this has been interpreted as "data."

As per claim 18, line 2, "and/or" is unclear and for the purposes of applying prior art will be interpreted as "or" only.

Claims 2-9 and 11-18 incorporate the deficiencies of claims 1 and 10 through dependency, and are therefore rejected for the same reasons as claims 1 and 10.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10-18 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d 1053, 1057, 22 USPQ2d 1033, 1036 (Fed. Cir. 1992). The mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application. Here, Applicant has claimed “processing said patient’s healthcare information on a HIPAA compliant website.” The “processing” in this claim appears to be so broad as to not be a specific or substantial (i.e., useful) result. Thus, claim 10 is rejected under 35

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U.S.C. 101 as failing to provide a useful result, and thus failing to accomplish a practical application.

Similar analysis applies to claims 11-18.

NOTE: For purposes of applying art, the examiner interprets the claims as best as possible in light of the 101 and 112 issues.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Wells et al. (US 2003/0200226 A1).

(A) As per claim 10, Wells discloses a method for accessing and viewing patient data, wherein a user is able to search for patients using a web portal, wherein a list of patients assigned to the wireless device user are retrieved from the HIS (Hospital Information System), wherein an HTML text string is created and returned to the Palm VII or web-enabled device where it is processed and displayed to the user (Fig. 1-2, par. 14-17, par. 18-19, par. 30, par. 78-90), wherein the system, including the web portal

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using the SSL protocol, complies with HIPAA regulations regarding security of the data (Fig. 1-2, par. 15-16).

(B) As per claim 11, Wells discloses inputting information related to a patient's diagnosis codes, procedure codes, and data of service through the web portal (par. 14-18, par. 26-27, par. 29-30, par. 33-36). As per the recitation of the "HIPAA compliant website", note the rejection of claim 10.

(C) As per claim 12, Wells discloses allowing users to place orders for diagnostic tests, medications, and other hospital based services through an order entry application and view the results of patients via a results application, wherein the user can view the results based upon time parameters, such as in the last two days, five days, or based upon the result type (lab, x-ray, nursing comments) (par. 28 through par. 36).

(D) As per claim 13, Wells discloses extracting summary information about a patient and building an HTML (Hypertext Markup Language) page that provides patient information and links to the patient's orders, results, billing, and other pertinent clinical information (reads on "text report") (par. 85).

(E) As per claim 14, Wells discloses allowing users to place orders for diagnostic tests, medications, and other hospital based services through an order entry application and view the results of patients via a results application, wherein the user can view the

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results based upon time parameters, such as in the last two days, five days, or based upon the result type (lab, x-ray, nursing comments) (par. 28 through par. 36).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. (US 2003/0200226 A1) in view of Joao (6,283,761).

(A) As per claim 1, Wells discloses a system for providing users the ability to connect with databases over the Internet through a web portal by logging in to the web portal using a user id and password, wherein the users can access and view patient information, wherein the patient information is stored in the databases, wherein the databases storing patient information are accessed through a security application that is used to authenticate users, wherein the databases are provided in a client server network (Fig. 1-2, par. 6, par. 16, par. 18, par. 24-25, par. 28-30, par. 36, par. 38, par. 43-51, par. 56, par. 63).

Wells does not explicitly state that the databases containing patient information are stored on a server. Thus, the Examiner has provided the Joao reference for

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teaching a server having a database containing patient information (col. 15 line 59 to col. 16 line 37).

At the time the invention was made, it would have been obvious to include the features of Joao within the method of Wells with the motivation of allowing a user to access patient information remotely and at the point of treatment (Joao; col. 1 lines 46-62).

(B) As per claim 2, Wells discloses users comprising health care providers such as physicians (par. 27).

(C) As per claim 3, Wells discloses accessing the web portal running and using a browser on a wireless handheld device that is to connect to the Internet (Fig. 1-2, par. 16-17, par. 20-23).

(D) As per claims 4-5, Wells discloses accessing patient information by requiring users to login to a connectivity server by entering a user id and password and the connectivity server performing authentication, wherein the user ids and passwords are assigned by the web portal provider and are user specific (par. 18, par. 24, par. 38, par. 44-51, par. 56, par. 63, par. 66).

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(E) As per claim 6, Wells discloses connecting to the web portal over the Internet using a personal computer, a palm pilot (reads on “personal digital assistant”), and a cellular and WAP enabled mobile phone (Fig. 1-2, par. 16-17, par. 20-23).

(F) As per claim 7, Wells discloses accessing patient information including patient treatment and symptoms data and patient history and clinical information (orders, results, and medications) (par. 19, par. 29-32, par. 36, par. 66).

(G) As per claim 8, Wells discloses the system, including the web portal using the SSL protocol, complying with HIPAA regulations regarding security of the data (Fig. 1-2, par. 15-16).

(H) As per claim 9, Wells discloses the web portal being connected to the connectivity servers via Secure Sockets Layer (SSL), wherein SSL and encryption (reads on “coded”) are used to establish secure connections for the transfer of data, wherein the user initiates a login process via the web-enabled device by entering a user id and password through the login.htm page (reads on “coded”) (par. 15-16, par. 52, par. 55, par. 56, par. 74, par. 85). Note also the discussion in claim 8.

10. Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. (US 2003/0200226 A1) as applied to claim 10, and further in view of Brown (5,832,448).

(A) As per claim 15, the teachings of Wells are incorporated herein.

Wells fails to expressly disclose the text report comprising a graphic analysis of said patient's healthcare information changes over time.

Brown discloses as shown in Figure 3, a chart generated for patients, wherein the chart indicates a time period elapsed since the patient's most recent collection date and a control value calculated for the patient, wherein the values shown pertain to blood glucose, wherein the icons indicate the compliance of the corresponding patient with the prescribed measurement regimen (Fig. 3, col. 6 line 39 to col. 7 line 27).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Brown within the method of Wells with the motivation of proactively monitoring patients having a chronic disease or ongoing health condition and allowing a clinician to optimize efforts and minimize costs in managing the medical needs of a patients (Brown; col. 2 lines 53-64).

11. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. (US 2003/0200226 A1) as applied to claim 10, and further in view of Joao (6,283,761).

(A) As per claim 16, Wells discloses extracting summary information about a patient and building an HTML (Hypertext Markup Language) page that provides patient information and links to the patient's orders, results, billing, and other pertinent clinical

information (reads on "text report") (par. 85). Wells fails to expressly disclose a text report that is printable. Joao discloses an output device being a printer for printing reports by a health care provider (Fig. 1, col. 21 lines 1-24). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Joao within the method of Wells with the motivation of maintaining a hard copy of the report for reference and access of historical information.

(B) As per claims 17-18, Wells discloses communicating with payors or the government (par. 52). However, Wells fails to expressly disclose a text report being submitted to a third party payer, where the third party comprises worker's compensation insurance adjustor or other medical insurance adjustor. Joao discloses a payer device of a health insurer having a receiver for receiving information and evaluation reports (see col. 13 lines 8-20 for examples of other insurers) (col. 2 lines 55-62, col. 3 lines 34-45, col. 21 lines 54 to col. 22 line 10, col. 28 line 18 to col. 29 line 3). Further, Joao discloses a health insurer or payer's employee being a person who reviews claims and makes decisions based on an evaluation report recommending whether to pay or not pay a claim (reads on "medical insurance adjustor") (col. 2 lines 55-62, col. 3 lines 34-45, col. 21 lines 54 to col. 22 line 10, col. 28 line 18 to col. 29 line 15). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Joao within the method of Wells with the motivation of providing a payer of insurance claims with adequate information to make a decision as to whether to pay an insurance claim (see Joao; col. 28 line 18 to col. 29 line 15).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches diabetes management system and method for controlling blood glucose (5,822,715), method for transmitting medical information over a network (6,795,554), system and method for storing information on a wireless device (6,970,827), and electronic medical record system and method (US 2003/0208382).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. Any response to this action should be mailed to:

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"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.



Carolyn M. Bleck
Patent Examiner
Art Unit 3626